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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,676	10/22/2003	Michael Sudofsky	5502-102US	6123

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EXAMINER

SUTTON, KIMBERLY K

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/690,676

Applicant(s)

SUDOFKY, MICHAEL

Examiner

Kimberly K. Sutton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1 - 12, drawn to a clear mounting film, classified in class 428, subclass 40.1.
- II. Claims 13 - 16, drawn to a method of face mounting a graphic, classified in class 156, subclass 60.
- III. Claims 17 - 20, drawn to a method of making a two-sided tape, classified in class 156, subclass 278.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group III, claims 17 - 20 and Group I, claims 1 - 12 are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be made by a materially different process such as extruding the pressure sensitive adhesive onto one side of the support layer and covering it with the release liner.

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3. Inventions Group I, claims 1 - 12 and Group II, claims 13 - 16 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product can be practiced by a materially different product such as a double-sided pressure sensitive tape.

4. Inventions from Group II, claims 13-16, and Group III, claims 17-20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects (i.e. each process produces a different product).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Richard Woodbridge on July 6, 2005 a provisional election was made with traverse to prosecute the invention of a method of face mounting a graphic, claims 13 - 16. Affirmation of this election

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must be made by applicant in replying to this Office action. Claims 1 – 12 and 17 – 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No 5,505,801 to Harris in view of U.S. Patent No 6,730,397 B1 to Melancon et al.

Harris discloses a method of mounting a graphic using an optically clear double-sided adhesive film (column 2, line 27). One surface is adhered to the image side of a photographic film (column 2, lines 28-29). The second surface is adhered to a sheet of glass (column 2, lines 23-24). The method discloses that the mounting film and both adhesive surfaces are optically clear (column 6 line 67- column 7, line 3). Harris does not disclose the type of adhesive to be applied to the film, or the use of a protective layer on one surface of the film. Melancon et al. discloses the method of applying pressure sensitive adhesive to one side of

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double sided tape and heat activated adhesive to the other (column 14, lines 48-52). Melancon et al. also discloses the method of applying a release liner as temporary backing (column 4, lines 16-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to use a tape having pressure sensitive adhesive on one side and thermally activated adhesive on the other side and a release liner taught by Melancon et al. in the method of Harris for the purpose of employing the most appropriate adhesives for the mounting film and preserving the adhesive qualities of the pressure sensitive adhesive surface.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris and Melancon et al. as applied to claims 13 and 14 above, and further in view of U.S. Patent No 5,800,888 to Yasumoto et al.

Yasumoto et al. discloses a method of adhering two layers with a thermally activated adhesive composed of ethylene vinyl acetate and having a thickness of 30 μm (column 14, lines 8-9). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a thermally activated adhesive made of ethylene vinyl acetate with a thickness of 30 μm as taught by Yasumoto et al. in the mounting method of Harris and Melancon et al. to achieve sufficient adhering capability may occur (Yasumoto column 9, lines 20-22).

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9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harris, Melancon et al., Yasumoto et al. as applied to claim 13 above, and further in view of U.S. Patent No. 5,558,438 to Warr.

Warr discloses a reinforced bag with a method of adhering two layers with an acrylic pressure sensitive adhesive with a thickness between 0.4 and 1.4 mils (column 3, lines 56-58). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the acrylic pressure sensitive adhesive with a thickness of 0.4 -1.4 mils as taught by Warr in the mounting method of Harris, Melancon et al., and Yakumoto et al. to achieve the adhesive properties associated with this known adhesive material.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. Sutton whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kim Satter

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CHRIS FIORILLA
SUPERVISORY PATENT EXAMINER

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